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09/584,631	05/31/2000	Joseph K. Orr	17871/00101	4572

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EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/584,631	<b>Applicant(s)</b> ORR, JOSEPH K.	
	<b>Examiner</b> Quoc A. Tran	<b>Art Unit</b> 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to Amendment A, filed 04/21/2004.
2. Examiner's Requirement of Election /Restriction dated 03/17/2004 has been withdrawn in view of the Amendment A, filed 04/21/2004.
3. Claims 1-35 are currently pending in this application, claim 17 has been canceled. Claims 1, 13, 26, 30, 33 and 34 are independent claims.
4. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(IV), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 14-15, and 18-23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-15, recite the limitations "...master books " in page 4. There are insufficient antecedent basis for these limitations in the claims.

Claims 18-19, 21, and 23 recite the limitations "...a book" in pages 5-6. There are insufficient antecedent basis for these limitations in the claims.

Claims 20, and 22, recite the limitations "...books ... book " in page 5. There are insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

Claims 1-12, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-12 set forth non-functional descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the

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technological arts (i.e. a computer) to produce a "useful, concrete and tangible" result. For example, Claims 1-12, the "system" reads on a mental construct/abstract idea or at best a computer program, per se. The language such as "computer program...", "program code..." etc., does not clearly define structural elements and are not tangibly embodied on a computer readable medium. Claims 1-12 are interpreted as software per se, abstract ideas or mental construct and not tangibly embodied on a computer readable medium or hardware.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-13, 26, 28-31, and 33-35, are rejected under 35 U.S.C. 102(b) as being unpatentable by Matthews et al. (hereinafter Matthews) "Complete Reference FrontPage 2000" (Public Release 05/01/1999, By Osborn/McGraw-Hill, Ca, USA).**

**In regard to independent claim 13, "receiving input textual information in response to an input command", as taught by Matthews pages 66-67 (i.e. ...**

Page view allows you to create and edit a web page by adding and laying out

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formatted text, pictures...you can use page wizards, templates...Figure 2-1 and table 2-2), *"receiving an image from a computer screen and converting the input image into a predetermined format in response to an input command; and automatically combining said textual input with said image input to create a page containing said text and said input image in a common internet language"*, as taught by Matthews pages 129-142, see Figure 2-22 through 3-30 (i.e. Themes... having coordinated graphic elements, background images...themes can be modified ...wizard...prompted to apply the themes..HTML commands to apply the styles associated with the theme...), further as taught by Matthews pages 399-416, see Figure 11-15 (i.e. replacing graphics in a theme...relative positioning and wrapping text...).

**In regard to claims 1, 4, and 5**, are directed to a computer program for performing the method of claim 13, and are similarly rejected along the same rationale.

**In regard to dependent claim 2**, *"automatically reset the resolution of said image on the computer screen from a first resolution to a second resolution and to save the first resolution"*, as taught by Matthews page 222, see Figure (picture set up) on page 222 (i.e.. default ... is 600x64 pixels...you can use (keep Pixels), also as taught by Matthews pages 227-230, see Figure 5-22 (i.e. resolution set to Auto),(i.e.. working with photographs ... the picture will get smaller, but content remain the same...(a height about 64pixels)...).

**In regard to dependent claim 3**, *"automatically restore said first resolution to said saved image when the said program code combines textual*

*input and said image input*", as taught by Matthews pages 227-230, see Figure 5-22 (i.e. resolution set to Auto),(i.e.. working with photographs ... the picture will get smaller, but content remain the same...(a height about 64pixels)...), further as taught by Matthews pages 399-416, see Figure 11-15 (i.e. replacing graphics in a theme...relative positioning and wrapping text...).

**In regard to dependent claim 6**, *"program code which allows selected data fields of said page to be displayed to users while other data fields are hidden from the user display"*, as taught by Matthews pages 342-353, (i.e. ... what fields are necessary for the user to answer...), and also as taught by Matthews page 373, (i.e. ... insert note when you want to be visible...hidden while the web is being viewed...).

**In regard to dependent claim 7**, *"assign page numbers to each said page created and to allow selected pages to be displayed by the user in any desired order"*, as taught by Matthews pages 170-176, see Figure 4-18 (i.e.. filelist...tells FrontPage how you want the files in the template store in the web...).

**In regard to dependent claim 8**, *"common internet language is HTML"*, as taught by Matthews pages 460-462, (i.e. ...HTML...).

**In regard to dependent claim 9**, *"common internet language is XML"*, as taught by Matthews pages 524-525, (i.e. ...XML...).

**In regard to dependent claim 10**, *"program code containing a database of stored master pages, said pages having text and associated images thereon; program code to allow the user to display either the text or image portion of said*

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*stored master pages, and program code to automatically combine said portion of said master page with said input from the user to create an answer page”, as taught by Matthews pages 173-176, see Figure 4-21 through Figure 4-22 (i.e. ... creating page template...), also as taught by Matthews pages 66-67 (i.e. ... Page view allows you to create and edit a web page by adding and laying out formatted text, pictures...you can use page wizards, templates...Figure 2-1 and table 2-2), further as taught by Matthews pages 399-416, see Figure 11-15 (i.e. replacing graphics in a theme...relative positioning and wrapping text...).*

**In regard to dependent claim 11,** *“allow retrieval of at least one of said master pages and to compare said master page with said answer page”, as taught by Matthews pages 81-97, see Figure 2-14, 2-5, 2-17, and 2-22 (i.e. templates... create a ready-made page without interact with you. Wizards ...ask you a series of questions...a customized page is created...).*

**In regard to dependent claim 12,** *“retrieve a portion of a previously saved page; computer code for directly combining said portion of a previously saved page with said input textual information or image to create a new page; and computer code allowing the full previously saved page to be compared with said new page”, as taught by Matthews pages 66-67 (i.e. ... Page view allows you to create and edit a web page by adding and laying out formatted text, pictures...you can use page wizards, templates...Figure 2-1 and table 2-2), further as taught by Matthews pages 399-416 (i.e. replacing graphics in a theme...relative positioning and wrapping text...Figure 11-15...).*



**In regard to independent claim 26**, is directed to a system for performing the method of claim 13, and is similarly rejected along the same rationale.

**In regard to dependent claim 28**, is directed to a system for performing the method of claim 10, and is similarly rejected along the same rationale.

**In regard to dependent claim 29**, is directed to a system for performing the method of claim 11, and is similarly rejected along the same rationale.

**In regard to independent claim 30**, is directed to a system for performing the method of claim 13, and in further view of the following, and is similarly rejected along the same rationale;

*“means to store one or more pages having text and image information in a database; and means for making available said one or more pages available for display”, as taught by Matthews pages 64-65 (i.e. ... as each page is completed, save it...from page view using the preview button...to look at the web you created...).*

**In regard to dependent claim 31**, *“means to receive additional pages and add said additional pages in said database”, as taught by Matthews pages 64-65 (i.e. ... as each page is completed, save it and mark the task as complete...select the next page...open in page view...).*

**In regard to independent claim 33**, is directed to a system for performing the method of claim 13, and in further view of the following, and is similarly rejected along the same rationale;

*"means for transmitting said additional original pages to a remote site", as taught by Matthews pages 64-65 (i.e. ... allows you to directly deliver your webs to someone seeking them...).*

**In regard to independent claim 34**, is directed to a system for performing the method of claims 10, 13, and is similarly rejected along the same rationale.

**In regard to dependent claim 35**, is directed to a system for performing the method of claim 11, and is similarly rejected along the same rationale.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3,14-25, 27, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable by Matthews et al. (hereinafter Matthews)"Complete Reference FrontPage 2000" (Public Release 1999, By Osborn/McGraw-Hill, Ca, USA), in view of Killi et al. US Pub No. 2001/0039552 A1 filed 6/3/2001-provisional 60/180,356 filed 02/04/2000 (hereinafter '552).**

**Claim 14 is representing of claims 15, 21-22, 27 and 32;**

**In regard to dependent claim 14**, *"maintaining a database of... accessing individual pages of said ...; retrieving a portion of at least one of said*

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*master pages; and directly combining said retrieved portion with said input textual information or image to create in answer page*", as taught by Matthews pages 81-97, see Figure 2-14, 2-5, 2-17, and 2-22 (i.e. templates (i.e. master pages)... create a ready-made page without interact with you. Wizards ...ask you a series of questions...a customized page is created...),

Matthews does not explicitly teach, "*master books (i.e. as define by the Applicant specification, books in which computer tasks are visually described through actual screenshots)*", however as taught by '552 at page 1, paragraph [0008] (i.e..... The software program product comprises a screen capture ... capture a screen seen when using the first software program. The editor module can be adapted to add text related to the captured screen. The assembly module can be adapted to assemble the captured screen and text to form at least part of a second software program or a file that can be used with the second software program. Other modules may be present within the software program product...).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Matthews that embedded screenshot capture module for capturing screenshots, and store in a database for use with WebPages builder wizard. One of ordinary skill would be motivated to perform such a modification to enable a user to quantify approximately the amount of coverage given to each topic in the web page. In addition, page-oriented organization together with the fact that the pages are joined together in a sequential order with a continuity of material from page to page enhance the ability of the reader to better remember the location of various portions of the

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material involved (e.g., roughly how many pages from the pages currently in view) as taught by Matthews pages 24-26 (i.e.... navigation scheme...).

**In regard to dependent claim 15**, *“providing on-line access to at least one of the complete pages of said ...; and providing the ability to compare said complete page of said ... with said answer page”*, as taught by Matthews pages 853-855, see Figure 24-1, and 24-2 (i.e. ... identifying which pages to publish...web server...),

Matthews does not explicitly teach, *“master book (i.e. as define by the Applicant specification, books in which computer tasks are visually described through actual screenshots)”*, however as taught by ‘552 at page 1, paragraph [0008] (i.e..... The software program product comprises a screen capture ... capture a screen seen when using the first software program. The editor module can be adapted to add text related to the captured screen. The assembly module can be adapted to assemble the captured screen and text to form at least part of a second software program or a file that can be used with the second software program. Other modules may be present within the software program product...).

**In regard to dependent claim 16**, *“maintaining a database of authorized users; and providing the ability to deny access to unauthorized users”*, as taught by Matthews pages 761-776 see Figure 24-1, and 24-2 (i.e. ... user account control...).

**In regard to dependent claims 18-20**, incorporate substantially similar subject matter as cited in claims 13-16 above, and are similarly rejected along the same rationale.

**In regard to dependent claim 21,** *“providing the ability to transfer said book to a remote location”*, as taught by Matthews pages 853-855, see

Figure 24-1, and 24-2 (i.e. ... identifying which pages to publish...web server...),

Matthews does not explicitly teach, *“book (i.e. as define by the Applicant specification, books in which computer tasks are visually described through actual screenshots)”*, however as taught by ‘552 at page 1, paragraph [0008] (i.e..... The software program product comprises a screen capture ... capture a screen seen when using the first software program. The editor module can be adapted to add text related to the captured screen. The assembly module can be adapted to assemble the captured screen and text to form at least part of a second software program or a file that can be used with the second software program. Other modules may be present within the software program product...).

**In regard to dependent claim 22,** *“combining said automatically combined page with individual pages from each of said books to create a new book”*, as taught by Matthews pages 104-117, see Figure 3-1through 3-8 (i.e. ... web wizards...creating the first web page, then add additional pages...)

Matthews does not explicitly teach, *“ books (i.e. as define by the Applicant specification, books in which computer tasks are visually described through actual screenshots)”*, however as taught by ‘552 at page 1, paragraph [0008] (i.e..... The software program product comprises a screen capture ... capture a screen seen when using the first software program. The editor module can be adapted to add text related to the captured screen. The assembly module can be adapted to assemble the captured screen and text to form at least part of a

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second software program or a file that can be used with the second software program. Other modules may be present within the software program product...).

**In regard to dependent claims 23-25**, incorporate substantially similar subject matter as cited in claim 16 above, and are similarly rejected along the same rationale.

**In regard to dependent claim 27**, *"means for associating two or more of said original pages as a book"*, as taught by '552 at page 1, paragraph [0008] (i.e..... The software program product comprises a screen capture ... capture a screen seen when using the first software program. The editor module can be adapted to add text related to the captured screen. The assembly module can be adapted to assemble the captured screen and text to form at least part of a second software program or a file that can be used with the second software program. Other modules may be present within the software program product...).

**In regard to dependent claim 32**, *"means for associating predetermined groups of pages into ..."*, Matthews pages 81-98, see Figure 2-22 and 2-23 (i.e. templates... create a ready-made page without interact with you. Wizards ...ask you a series of questions...a customized page is created... hyperlinks view allows you to look at ...the pages in the web...).

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kerr et al. U.S. Patent No. 4,772,206 issued 09/20/1998 filed 03/10/1986.

Rowe et al. U.S. Patent No. 5,781,785 issued 07/14/1998 filed 09/26/1995.

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Lennon U.S. Pub No. 2003/0208473 A1 issued 11/06/2003 filed 01/28/2000.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781, **"After mid-Oct, 2004, the examiner can be reach at (571) 272- 4103"**. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**Quoc A. Tran**  
**Patent Examiner**  
**Technology Center 2176**  
**August 18, 2004**

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**